



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/736,631	12/14/2000	Charles M. Link II	BELL-0023/99213	8042

38952 7590 06/30/2004

WOODCOCK WASHBURN LLP
ONE LIBERTY PLACE - 46TH FLOOR
PHILADELPHIA, PA 19103

EXAMINER

WOO, STELLA L

ART UNIT	PAPER NUMBER
----------	--------------

2643

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/736,631

Applicant(s)

LINK ET AL.

Examiner

Stella L. Woo

Art Unit

2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-18,20-32 and 34-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-18,20-32 and 34-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 16, 20-22, 24-30, 34-36, 38-43 are rejected under 35 U.S.C. 102(e) as being anticipated by Bossemeyer, Jr. et al. (US 6,490,444, hereinafter "Bossemeyer").

Bossemeyer discloses a system for notifying a computing device (subscriber terminal 60 can be a personal computer; col. 5, line 66 – col. 6, line 4) of an incoming message (data message), the system comprising:

a message server (data message platform 40 coupled to a data network 200; Fig. 2; Fig3, step 100) for receiving the incoming message (data message is received at the data message platform; Fig. 6, step 100);

a public communications system (telecommunications network 60 coupled to data message platform 40), the message server for securely communicating to the communications system that the incoming message awaits retrieval by the computing device (message waiting signal is transmitted to the telecommunications network; Fig. 6, step 104); and

a communications line (telephone line connecting telecommunications network node 250 with subscriber terminal 80), the communications system for signaling the computing device

Art Unit: 2643

over the communications line that the incoming message awaits retrieval by such computing device (message waiting indication is transmitted to the subscriber terminal; Fig. 6, step 108),

wherein the incoming message includes a destination address (subscriber's email address; col. 3, lines 60-61), and wherein the communications line is identified by an identifier (telephone number of the subscriber; col. 3, lines 59-60), the system further comprising a database (subscriber database 230 is indexed by message address so that the subscriber's telephone number is retrieved so that a message waiting indication can be transmitted to the subscriber via the telephone line; col. 4, lines 17-46).

Regarding claims 28 and 42, Bossemeyer teaches the use of a stutter dial tone to indicate the presence of a waiting email message (col. 3, lines 17-25).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 17-18, 23, 31-32, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bossemeyer in view of Duphorne.

Bossemeyer differs from claims 17-18, 23, 31-32, 37 in that it does not specify signaling according to an on-hook signaling protocol. However, Duphorne teaches implementing an on-hook signaling protocol for receiving an email notification message (email notification signal is received via CallerID protocol; col. 3, line 48 - col. 4, line 31; col. 6, line 55 - col. 7, line 11)

Art Unit: 2643

such that it would have been obvious to an artisan of ordinary skill to incorporate such a signaling protocol, as taught by Duphorn, within the system of Bossemeyer so that the subscriber terminal can receive the notification message without going off-hook.

Regarding claims 23 and 37, caller ID signals are communicated via the SS7 network.

Response to Arguments

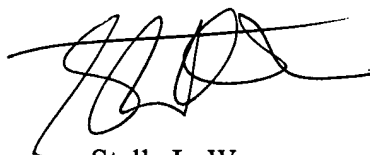
3. Applicant's arguments filed April 19, 2004 have been fully considered but they are not persuasive. Applicant argues that "the Bossemeyer reference does not disclose that the platform 40 (i.e., message server) checks such such a database 230 to determine a phone number corresponding to an email address, as is required by claims 16 and 30." However, Bossemeyer clearly teaches an embodiment in which the subscriber database is searched by an email address in order to determine an associated phone number (see Figure 6; col. 4, lines 25-46).

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stella L. Woo whose telephone number is (703) 305-4395. The examiner can normally be reached on Monday-Tuesday, Thursday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (703) 305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2643

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to be 'Stella L. Woo', written in a cursive style.

Stella L. Woo
Primary Examiner
Art Unit 2643